

## **Remarks:**

### **IDS References missing from “List of References cited by applicant & considered ...”:**

Only the IDS signature page was included. Applicant believes that the page that listed the patent references may have been unintentionally omitted from the Office Action “List of References Considered”. Applicant believes these are probably the patents that Collaborating-Examiner Ella Colbert described as the “ErinMedia patents” during first interview. Applicant respectfully requests that the references be included, so the record will be complete.

### **Asserted Admission of Prior Art (Office Action page 2):**

The Office Action asserted an “Admission of Prior Art under MPEP 2144.03[R-1] C”. The applicant respectfully traverses this assertion made in the Office Action for at least the following reasons. Applicant believes he did traverse the iTunes and iPod in his response to the first Office Action (Amendment D). In particular, the iTunes and iPod were traversed and discussed in detail in Amendment D: on page 17 (paragraphs 2 and 3); and in significant portions of the text on pages 19, 20 and 21.

### **Claim Objections Informalities (Office Action page 3):**

The Office Action objected to claim 121 for informalities, specifically, for not beginning each method claim element with an action word ending in “ing”.

The applicant respectfully traverses the rejection, for at least the following reasons. The applicant is not aware of and the Office Action does not cite a USC; CFR; MPEP or Court-Ruling that specifically requires the first word of each element in a method claim to begin with an action word ending in “ing”.

However, the applicant has re-arranged claim 121 so that each element begins with an action word ending in “ing”. The applicant believes the meaning of the claim has not changed by moving the “ing” word or phrase to the beginning of each element.

**112 Rejections for being “Indefinite” (Office Action page 3-4):**

(a) The Office Action had rejected claims 101, 121 and 140 under 35 USC 112 for being indefinite because a “sequence is never provided by the claim”.

The preamble of the independent claims has been changed to the broader phrase: “personalized music or entertainment”. This phrase is from the application title.

(b) The Office Action (on page 4) had rejected claims 101, 121 and 140 under 35 USC 112 for insufficient antecedent basis (for the use of “said” in the second element).

The antecedent has been clarified.

**Double Patenting (Office Action page 4):**

The Office Action described Double Patenting. The applicant respectfully traverses the rejection, for at least the following reasons. The Office Action did not specifically identify two different patents or applications that were alleged to be claiming the “same invention”.

**CFR 1.75 Objection for “Substantial Duplicate” Claims (Office Action pages 4-5):**

The Office Action had under 37 CFR 1.75 objected to claims 121-139 as being “a substantial duplicate” of claims 101-120.

The applicant respectfully traverses the rejection, for at least the following reasons. The 4<sup>th</sup> element in the original claim 121 is significantly different from the 4<sup>th</sup> element of original claim 101.

Since the independent claim 121 is not “a substantial duplicate” of independent claim 101; then dependent claims 122-139 are also not “substantial duplicate”. Hence, applicant believes the dependent claims 122-139 would be allowable even if they remain dependent on parent claim 121.

However, the applicant would like to thank the Examiner for prompting the applicant to consider this. Because, the applicant now recognizes that a more diverse claim protection will be obtained by having one set of dependent claims under an independent method claim (101) and another

set of dependent claims under an independent apparatus claim.

Therefore, in-order to increase the claim diversity, the second set of dependent method claims (122 to 139) have been canceled. Independent apparatus claim 140 has been canceled. A new (clearer) independent apparatus claim 141 has been added. New dependent claims have added under the new independent apparatus claim 141. Dependent claims are now under both an method and apparatus independent claim.

**101 Rejection (Office Action page 5):**

The Office Action had rejected claims 101-140 under 35 USC 101 for being directed to non-statutory subject matter. The Office Action alleged that “claims 101, 121; and 140 are drawn to method and apparatus that can and is performed by humans everyday” and also that “the claims do not explicitly set forth that a computer network or a machine is performing all the steps necessary to perform said method”.

The applicant respectfully traverses the rejection, for at least the following reasons:

(a) Applicant believes that the prior human process considers what is currently being experienced and establishes a preference; well before before taking action. The prior human process does not note the applied actions and does not utilize the applied actions to form a preference. And the prior human process does not consider the applied actions and update the user's preference based on those applied actions.

For example, consider a user who doesn't like country music. The user may take action in-order to avoid a country music composition (e.g., “pressing the forward button” to skip the rest of a currently playing country composition). But the user did not think: “I just pressed the forward button to skip the rest of the currently playing composition ... that may mean I don't like that composition ... therefore I should lower my preference for that composition because I pressed that button”. In reality, the user had established his preference before taking that action (e.g., before “pressing the forward button”). Therefore, in the prior human process, the user did not utilize the applied actions in-order to determine or update their preference.

Hence, in claims 101; 121 and 140; both the second (“capturing”) and third (“updating”) claim elements are not done by the prior human process.

Applicant believes that a claim for a set of elements that are new and which create a useful end-result is patentable subject matter; even if they are manually performed. It is not required that they be performed by a “computer or a machine” in-order to be patentable subject matter.

Since claims 101; 121 and 140 as a whole have not been performed by a prior human process, the applicant believes the claims are patentable even if they were to be manually performed by a human. Note however, that the word “automatically” is in the independent claims.

Also note that for at least the above reasons: claims 101; 121 and 140 have not been performed by the prior human process; and hence, are not an automation of a currently performed human process.

A similar argument may also be applied to each of the dependent claims [e.g., the user did not think: “I just did \_\_\_\_\_ ... that may mean I like/don't like that composition ... therefore I should raise/lower my preference for that composition]. Hence, for at least the above reasons: each of the dependent claims have not been performed by the prior human process; and hence, are not an automation of a currently performed human process.

In addition, because each dependent claim includes the elements of the independent claims that have not been done by the prior human process; each dependent claim would also differ from the prior human process.

### **102 Rejection (Office Action page 6-7):**

The Office Action had rejected claims 101; 103-113; 117; 120; 121; 123-134; 139 and 140 under USC 102(a) for being anticipated by U.S. Patent 7,146,329 (“Conkwright”). The applicant respectfully traverses the rejections, for at least the following reasons.

Claims 101; 121; 140 (Independent Claims):

Conkwright is based on demographics and hence is focused on determining the demographic group(s) or other group(s) that a user fits within.

Conkwright “determine one or more user models based on user interactions with the set-

top box” (Abstract: 2<sup>nd</sup> sentence). In Conkwright, “user-model” refers a set of demographic parameters [e.g., age-range sex; race/ethnic-group; income-range; education level; etc] (column 36, lines 21-36) or interest-group [e.g., group interested in home-improvement; etc] that correspond to a user.

For example, the demographic parameters in the column headings in Figures 22(a) to Figure 22(l) are examples of the demographic parameters of a “user model”. The rows in Figures 22(a) to Figure 22(l) are then populated (by using the described math processes) with probabilities based on user interactions with the set-top box (so different user-models can even be determined for different time-intervals).

Therefore, Conkwright uses set top box events to determine one or more groups [the user model(s)] that a user is likely to be in .

In Conkwright, the “content to be displayed on the set top box is selected based on the user model” (Abstract: 2<sup>nd</sup> sentence; and Column 39, line 41 to Column 40, line 43 and Figure 25). Therefore, Conkwright then uses the user model(s) to “select from among transmitted content based on correlation of user model(s) and content attributes” [Figure 25, box 2521]. Therefore, Conkwright selects content that is intended for the group(s) the user has been determined to be in.

Conkwright suffers many deficiencies that are similar to other prior art approaches that define the user as fitting in some group(s). For example, in some prior art, the user may manually complete a profile which is then used to place the user in a group. Conkwright and these prior art approaches assume that all users in a group have the same tastes. But each user is unique. An individual may not like everything that the group is suppose to like. And, the user may like other things that are outside the defined group. Hence, Conkwright is not personalized to each individual user.

Because Conkwright uses mathematical probabilities/estimating, it is possible that the user may be determined to be in the wrong group(s) and the user will receive unsuitable content.

In addition, with Conkwright, the content that is selected for the user will only change, when the set-top-box events cause a change in the the group(s) the user is determined to be in. Hence, Conkwright is not able to adapt in a personalized manner for a user.

In summary of the above, applicant believes that Conkwright does not determine a user preference. Hence, Conkwright does not do the 2<sup>nd</sup> and 3<sup>rd</sup> elements in the independent claims [i.e., Conkwright does not: “capture” and “update” a user preference based on applying different actions on said pieces or compositions].

In addition, applicant also believes that, since Conkwright never determines a user preference, Conkwright does not “select” based upon “said updated user preferences”. Hence, Conkwright also does not perform the 4<sup>th</sup> element in the independent claims.

In addition, in order to clarify the independent claims, applicant is now using “determining” instead of “capturing” in each independent claim.

Claims 103 and 123:

Applicant respectfully traverses the assertion that “select a particular piece or composition for playback” is equivalent to “changing the channel in Conkwright”. The Office action has only made a generalized assertion of similarity.

Applicant believes that “select a particular piece or composition for playback” was not foreseen by Conkwright and would be a useful improvement to Conkwright. Even if these could be equated, Conkwright does not capture or update a user's preference based on user action to “select a particular piece or composition for playback”. Conkwright uses set-top box events in-order to determine the group(s) the user is in.

Claims 104-110 and 124-130:

Applicant respectfully traverses the assertion. In cited column 3 lines 52-55, Conkwright is using “what ... content were watched” and “what portions ... were watched” in-order to “project sampled data more accurately to the population at large” (i.e., to obtain an improved Nielson-type ratings). Applicant believes that the cited Conkwright sections do not describe the capturing or updating of a user's preference. The Office action has only made a generalized assertion of similarity. The Office action has not specified were the prior art has utilized each specific element in these dependent claims. Conkwright uses set-top box events to determine the group(s) the user is in [i.e., “user model(s)”]. Hence, Conkwright does not capture or update a user's preference based on each of

the elements in each these dependent claims. And, Conkwright does not “select” based upon “said user preferences”.

Claims 111-113 and 131-133:

Applicant traverses the rejection for at least the following reasons. The cited location in Conkwright does not discuss each of the specific claimed elements in each of these dependent claims. Applicant believes that a proper 102 rejection requires all the claim elements to be found in a single prior art. The Office Action appears to be combining Conkwright with other limitations taken from “Admitted Prior Art as set forth in section 3”. Trying to combining limitations from different cited prior art is not proper under a 102 rejection.

In addition, the applicant traversed the allegation of “Admitted Prior Art as set forth in section 3” in his response to the first Office Action (Amendment D), as well as in the “Asserted Admission of Prior Art (Office Action page 2)” discussion above.

However, applicant has decided to cancel claims 111 and 131, in order to include new dependent claims in this application. Applicant reserves the right to prosecute claims for this different inventive matter at a later time or in a continuing application.

Claims 117 and 134:

Applicant traverses the rejection for at least the following reasons. Although Conkwright monitors set-top-box events, applicant believes that Conkwright does not save a history of details about individual said applied actions so that a user's preference can be determined using the saved history of the user's actions.

Claims 120 and 139:

Applicant traverses the rejection for at least the following reasons. Applicant believes that Conkwright monitors set-top-box events in-order to determine which group a user is in. Applicant disagrees with the assertion that Conkwright determines “user's preferences”. In addition, applicant believes that Conkwright is not selecting based on the determined user's preferences.

However, applicant is canceling these two claims, in order to include new dependent claims in this application. Applicant reserves the right to prosecute claims for this different inventive matter at a later time or in a continuing application.

**103(a) Rejection (Office Action page 7-8):**

The Office Action had rejected claims 101-140 under 35 USC 103(a) as being unpatentable over Admitted Prior Art (APA) in view of *In re Venner*, 120 USPQ 192 (CCPA 1958) and *In re Rundell*, 9 USPQ 220". Specifically, the Office Action alleged that the claims are "simply automating a process previously manually done".

The applicant respectfully traverses the rejection, for at least the following reasons, which are an alternative expression of the reasons stated in Amendment D; page 22 (amendment after the first Office Action).

The applicant believes the prior human process does not utilize the claimed elements. Applicant believes, the prior human process considers what is currently being experienced and establishes a preference; well before before taking action. The prior human process does not note the applied actions and does not utilize the applied actions to form a preference. And the prior human process does not consider the applied actions and then update the user's preference based on those applied actions.

For example, consider a user who doesn't like country music. The user may take action in-order to avoid a country music composition (e.g., "pressing the forward button" to skip the rest of a currently playing country composition). But the user did not think: "I just pressed the forward button to skip the rest of the currently playing composition ... that may mean I don't like that composition ... therefore I should lower my preference for that composition because I pressed that button". In reality, the user had established his preference before taking that action (e.g., before "pressing the forward button"). In the prior human process, the user did not utilize the applied actions in-order to determine or update their preference.

Hence, in claims 101 and 121; both the second ("capturing"/"capture") and third ("updating") claim elements are not done by the prior human process. The prior human process does not utilize the user's applied actions to determine or update a preference. Therefore, for at least the above reasons, claims 101 and 121 are not an automation of a currently performed human process. These same or



similar arguments also apply to the independent apparatus claim.

Hence by at least the arguments above, the applicant respectfully traverses the Office Action assertion that “it is not seen wherein applicant has invented something novel and unique, merely automated something we all do naturally”.

That the Examiner did not previously appreciate the differences between the prior human process and the Applicant's invention may be considered additional proof that the Applicant's invention is not obvious.

A similar argument may also be applied to each of the dependent claims. That is, the user did not think: “I just did \_\_\_\_\_ (as in dependent claim); that may mean I like/don't like that composition ... therefore I should raise/lower my preference for that composition. Hence by at least the arguments above, the applicant respectfully traverses the Office Action assertion that “all dependent claims are merely verbalizing actions performed by the person”.

In addition, because the dependent claims include elements of the independent claims that have not been done by the prior human process; each dependent claim would also differ from from the prior human process.

The Applicant also respectfully traverses the Office Action statement that “it is considered that the more a person loathes a specific type of music , the faster they will try to get it shut off. Another example is when children listen to the same song or watch the same movie over and over again”. Applicant believes these comments, about observed human reactions, is at least partially based on hindsight after having been exposed to the applicant's invention. Even if such observed human reactions was previously appreciated in the prior art, there has not been a showing that the prior art has utilized the applied actions, that correspond to such human reactions, as in the Applicant's claims.

**103(a) Rejection (Office Action page 9-10):**

The Office Action had rejected claims 102; 114-116; 118; 119; 122; 134-136 and 139 under 35 USC 103(a) as being unpatentable over U.S. Patent 7, 146,329 (“Conkwright”) further in view of Cohn and Fanning. The applicant respectfully traverses the rejection, for at least the following reasons.

Even if one was able to apply Fanning and Cohen ( playcount; last played) to Conkwright, Conkwright would only be using additional measures of set top box events to determine which group(s)

a user is in. Conkwright along with these two references still does not do/have the 2<sup>nd</sup>; 3<sup>rd</sup> and 4<sup>th</sup> elements in each of the independent claims. Hence, combining these three references as does not result in all the elements of the claimed invention.

In addition, the applicant respectfully traverses the rejection for each of the rejected dependent claims, for at least the following reasons, discussed below:

Claims 102 and 122:

The Office Action indicates that “repeat; replay or go-back-to” is not disclosed in Conkwright. But the Office Action fails to point out how/where “repeat; replay or go-back to” is disclosed in Fanning and Cohen so they can be combined with Conkwright. Even if “repeat; replay or go-back to a piece or composition that previously played” where to be found in Fanning and Cohen, applicant respectfully traverses the rational for combining these references.

In addition, even if one was able to combine Fanning and Cohen ( playcount; last played) to Conkwright; the Conkwright-combination would only be using additional measures to determine which group(s) a user is in. And, the Conkwright-combination would still not determine a user's preference.

Claims 114-116 and 134-136:

As disclosed in Fanning, the iTunes “My Rating” allows the user to manually “rate each track with a score out of five stars”. As disclosed in Fanning, with iTunes the user can create a “Smart Playlists(s)” based on the “My ratings”; playcount; last played; etc. But Fanning does not disclose that when a user selects a “smart playlist” for playback, that the frequency that a song (in the “smart playlist”) is played is influenced by the “My ratings”; playcount; last played; etc.

In addition, the Office Action fails to point out that or where each of the specific elements in the dependent claims are disclosed in Fanning and Cohen. Even if the specific elements could be found in Fanning and Cohen, applicant respectfully traverses the rational for combining these references. In addition, even if one was able to combine Fanning and Cohen ( “My Ratings”; playcount; last played) to Conkwright; the Conkwright-combination would

only be using additional measures to determine which group(s) a user is in. And, the Conkwright-combination would still not determine a user's preference.

Claims 118, 119, 139:

The obviousness rejection is improper because, the Office Action fails to point out that or where each of the specific elements in the dependent claims are disclosed in Fanning and Cohen. Even if the specific elements could be found in Fanning and Cohen, applicant respectfully traverses the rationale for combining these references. In addition, even if one was able to combine Fanning and Cohen ( “My Ratings”; playcount; last played) to Conkwright; the Conkwright-combination would only be using additional measures to determine which group(s) a user is in. And, the Conkwright-combination would still not determine a user's preference.

**Summary:**

The independent method claim 101 has been amended. Dependent claims 102-105 are unchanged. Dependent claims 106-110 and 112-118 have been amended into a simpler and clearer form. Three dependent claims (111 and 119-120) have been canceled in-order to add three new dependent claims (160-162).

The independent method claim 121 has been amended into a simpler and clearer form. Dependent claims 122 to 139 have been canceled in-order to add new dependent claims (142 to 159) under the new clearer apparatus claim (141). Independent apparatus claim 140 was canceled.

The number of independent claims (3) and total claims (40) in the application are unchanged.

The applicant believes all the claims are in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the Applicant.

Respectfully submitted,

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